



UNITED STATES PATENT AND TRADEMARK OFFICE

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
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Paper No. 3

DANIELS & DANIELS, P.A.
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OFFICE OF PETITIONS

In re Application of :
John B. Terry (Deceased) & Jeffrey A. Hales :
Application No. 09/933,323 :
Filed: August 20, 2001 : DECISION ON PETITION
Docket No. 0960-020 :
:

This is in response to the petition filed August 20, 2001, which is being treated as a petition under 37 CFR 1.181 to accept the declaration filed concurrently with the instant petition.¹

The petition is dismissed.

Any petition for reconsideration of this decision must be filed within two months from the mail date of this decision.

Petitioner states that joint inventor John B. Terry died recently and that it is uncertain when Mr. Terry's estate will be sent to probate court. Therefore, petitioner requests the Patent and Trademark Office to accept the oath/declaration filed concurrently with the instant petition.

As joint inventor John B. Terry is deceased, 37 CFR 1.42 applies. See MPEP 409.01(a). 37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 USC 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. Therefore, petitioner should carefully consider MPEP 409.03(c) as to under what circumstances Rule 47 is inapplicable as compared to 37 CFR 1.42, and make the appropriate showing as to whether 37 CFR 1.42 or 1.47 is controlling here. However, if the legal representative or heir(s) of the deceased inventor cannot be found or reached after diligent effort, or, having been found and presented with a **complete** copy of the

¹ Since 37 CFR 1.47 is not applicable at this time, the petition is being treated as a petition under 37 CFR 1.181.

application papers (specification, claims and drawings) refuses to sign the declaration, then 37 CFR 1.47(a) applies. Currently, the showing fails to establish that a diligent effort was made to locate the legal representative or heirs of the decedent. Assuming that Rule 47 is controlling, any future petition must establish, with a documented showing, the diligent effort that has been made, or will be made, to locate the legal representative or heir of the decedent.

The oath or declaration for the patent application must be in compliance with 37 CFR 1.63 and 1.64. The declaration under 37 CFR 1.63 and 1.64 must set forth the citizenship, residence, and post office address of the forthcoming legal representative or heir. Note also 37 CFR 1.76, except that the citizenship must be listed on the declaration. Attention is directed to 37 CFR 1.63(a)(3); MPEP §§ 605.02, 605.03.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Frances Hicks at (703) 305-8680.

Since 37 CFR 1.47(a), as explained above, does not apply to this application, this application is being returned to the Office of Initial Patent Examination Division for mailing of a Notice to File Missing Parts of Nonprovisional Application.



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy